

REMARKS

In the Office Action mailed January 17, 2003, Claim 6 is rejected under 35 U.S.C. §101. Claims 6, 7 and 9-12 are rejected under 35 U.S.C. §102(b), as being anticipated by WO 96/02323A1 in the name of Müller et al. (translated as U.S. Pat. No. 5,859,265). Claims 8 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/02323A1 in the name of Müller et al. as applied to Claim 6 and further in view of U.S. Pat. No. 6,031,116 issued to Bowman et al. Claims 6, 8-11, 13 and 14 are rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Rejections under 35 U.S.C. §112, second paragraph

Claims 6, 8-11, 13 and 14 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner continues to maintain that Claim 6 specifies the use of a catalyst for oxidation but does not set forth any steps involved in the method. Although Applicants respectfully disagree and maintain that recitation of "contacting" in Claim 6 is a step, they have followed the Examiner's suggestion replacing the words "used for" with --deactivated by-- and have added the words --the step of-- after the word "comprising".

The Examiner further contends that Claim 13 added by the RCE Amendment filed December 19, 2002 is improperly numbered as there was already a Claim 13 in the application. Applicants respectfully disagree. An attempt was made to add a Claim 13 to the instant application by a Response after Final. Applicants note that the Examiner did not enter that Response, therefore no Claim 13 was added prior to the RCE Amendment of December 19, 2002.

Applicants submit that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §112, first paragraph, and respectfully request the Examiner reconsider and reverse his rejection of Claims 6, 8-11 and 13 under 35 U.S.C. §112, second paragraph, as being indefinite.

Rejections under 35 U.S.C. §101

Claim 6 is rejected under 35 U.S.C. §101, the Examiner contended that it recites a use without setting forth any steps involved in the process and thus

is an improper method claim. Although Applicants respectfully disagree and maintain that recitation of “contacting” in Claim 6 is a step, they have followed the Examiner’s suggestion replacing the words “used for” with --deactivated by-- and have added the words -- the step of-- after the word “comprising”.

Applicants submit that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §101, and respectfully request the Examiner reconsider and reverse his rejection of Claim 6 under 35 U.S.C. §101.

Rejections under 35 U.S.C. §102(b)

Claims 6, 7 and 9-12 are rejected under 35 U.S.C. §102(b), as being anticipated by WO 96/02323A1 in the name of Müller et al. (translated as U.S. Pat. No. 5,859,265). Applicants respectfully point out that Claim 12 was cancelled by the RCE Amendment filed December 19, 2002, thus obviating any grounds for rejection based upon that claim. Applicants respectfully disagree with the Examiner regarding Müller et al.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631,2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Müller et al. does so. Particularly, the Examiner has failed to point to where Müller et al. discloses or suggests the instantly claimed method of regenerating the claimed catalyst. The catalyst of Müller et al. as stated at col. 1, lines 7-11 is,

“... a novel oxidation catalyst based on a titanium or vanadium silicalite having a zeolite structure and containing platinum metals....” (emphasis added)

Applicants note that the Examiner continues to fail to cite a reference in support therefor, that titanium silicalite is “composed of titanium dioxide and

silicon dioxide". Therefore, following the Examiner's reasoning, one embodiment of the catalyst of Müller et al. is based on titanium dioxide and silicon dioxide containing one or more platinum metals and optionally, gold. In contradistinction, the instantly claimed catalyst is based on a titanium dioxide or a hydrous titanium dioxide support coated with gold particles, wherein the catalyst has been used for oxidation of unsaturated hydrocarbons in a gas phase.

In his response to Applicants' arguments, the Examiner appears to argue that the language "titanium dioxide or a hydrous titanium dioxide" is open ended because it follows the word "comprising". Applicants disagree and note that the language in question (i.e., "titanium dioxide or a hydrous titanium dioxide") is part of a wherein clause which limits the catalyst, whereas the comprising language refers to the step of the instantly claimed method.

Therefore, Applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 6, 7 and 9-11 under 35 U.S.C. §102(b), as being anticipated by WO 96/02323A1 in the name of Müller et al. (translated as U.S. Pat. No. 5,859,265).

Rejections under 35 U.S.C. §103(a)

Claims 8 and 14(13) are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/02323A1 in the name of Müller et al. as applied to Claim 6 and further in view of U.S. Pat. No. 6,031,116 issued to Bowman et al. Applicants respectfully disagree with the Examiner's contention regarding the cited art.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition given in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) that,

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants respectfully contend that the Examiner has failed to do so in the instant Office Action. Clearly, there is no such teaching, suggestion or motivation shown in the references in this case. Applicants' comments with respect to the rejection above are equally applicable to the present rejection. Müller et al. does not disclose or suggest the instantly claimed invention. Further, the Examiner has failed to point to where Bowman et al. adds the missing teaching or suggestion to lead one of ordinary skill in the art to the instantly claimed invention.

Therefore, Applicants contend that nothing in the combined teaching of Müller et al. and Bowman et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of Claims 8 and 14(13) under 35 U.S.C. §103(a) as being unpatentable over WO 96/02323A1 in the name of Müller et al. as applied to Claim 6 and further in view of U.S. Pat. No. 6,031,116 issued to Bowman et al.

Conclusion

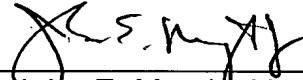
Applicants have amended Claim 6. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicants contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 6-11 and 13. If the Examiner is of the

opinion that the instant application is in condition for other than allowance, he is requested to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By



John E. Mrozniski, Jr.
Attorney for Applicants
Reg. No. 46,179

Bayer Polymers LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
PHONE: (412) 777-8336
FACSIMILE PHONE NUMBER:
412-777-8363
s/rmc/jem/0076